REMARKS

Claims 16, 17 and 20-27 are pending in the present application. Claims 16, 17 and 20-27 have been rejected. By this Amendment, claims 16, 22, 26 and 27 have been amended. It is respectfully submitted that the pending claims define allowable subject matter.

Claims 16-17, 20, 22-23, and 25-27 stand rejected under 35 U.S.C. 103(a) as being unpatentable over United States Patent No. 5,497,502 ("Castille") in view of United States Patent No. 4,949,187 ("Cohen") and further in view of United States Patent No. 4,667,802 ("Verduin") or United States Patent No. 4,958,835 ("Tashiro"). Claims 21 and 24 are rejected under 35 U.S.C. 102(a) as being unpatentable over Castille in view of Cohen in view of Verduin or Tashiro in view of Official Notice. Claims 16-17, 20, 22-23, and 25-27 stand rejected under 35 U.S.C. 103(a) as being unpatentable over British patent GB 2 193 420 ("William") in view of Audiocomp. Claims 21 and 24 were rejected under 35 U.S.C. 103(a) as being unpatentable over William in view of Official Notice. The Applicants respectfully traverse these rejections for the reasons already set forth during prosecution of the present application, and as set forth below.

The Applicants first turn to the rejection of claims 16-17, 20, 22-23, and 25-27 under 35 U.S.C. 103(a) as being unpatentable over Castille in view of Cohen and further in view of Verduin or Tashiro. The Examiner acknowledged that Castille does not disclose (1) storing received compressed digital song data in a data storage unit; (2) a money intake device; or (3) a user attract mode, all of which are recited in claim 16 of the present application. Additionally, the Applicants note that Castille does not teach, nor suggest, a money intake device, even when the device is interpreted, as Applicants intend, to include devices in which the money is represented, for instance, by units that indicate that the user has "credits" that are to be applied to payment for the playing of a song. Further, as discussed previously during the prosecution of the present application, Castille does not teach, nor suggest, a computer jukebox, as claimed in the present application. Rather, Castille relates to "a method and apparatus for transmitting information recorded on a collection of digital disks from a central server via a high data rate digital telecommunications network to subscribers connected to the network." *See* Castille Abstract.

The Examiner submits, however, that "Castille teaches the functionality of a jukebox and is therefore seen to be equivalent to a physical jukebox." The Applicants respectfully disagree.

Castille does not teach, nor suggest, a system or method resembling a jukebox. Castille discloses a system in which users listen to sound recordings at home.

> The object of the present invention is to provide a method and apparatus making it possible to use a central computer capable of dialoging with local terminals from which *subscribers* may inform the central computer of the selection of information they desire to receive *at home*...

Castille at Column 1, lines 50-55 (emphasis added). Jukeboxes are commonly found in establishments such as restaurants and bars, but not in homes. Further, Castille goes on to state:

> The object of the invention is achieved by means of a method of transmitting information recorded on digital disks from a central server to subscribers via a telecommunications network.

Castille at Column 1, lines 61-64. The subscribers of Castille are the users of the system, i.e., the ones listening to the songs. Those who use jukeboxes are not subscribers. Bar or restaurant patrons do not subscribe to a network in order to play songs. Rather, the bar or restaurant patrons insert money into the jukebox to play assorted song recordings. Further, Castille states, "In this case, the result is the establishment of systems for delivery personalized music programs over the cables of a telecommunications network." Castille at Column 3, lines 3-5. A personalized music program is different than a jukebox. When a patron plays songs on a jukebox, everyone in the establishment is subjected to the songs. Similarly, the person who played a first set of songs is subjected to another set of songs played by another patron after the first set of songs are complete. Thus, jukeboxes are not personalized music programs tailored to the preferences of a particular individual. Rather, jukeboxes represent a communal musical selection system. In contrast, Castille discloses a system like a typical home cable system, such as a pay-per-view channel, that plays music as well as video programs. Thus, for at least these reasons, Castille does not teach, nor suggest, the functionality of a jukebox, and is therefore not equivalent to a physical jukebox.

The Applicants also note that Castille does not teach, nor suggest, "song associated pictorial graphics," as recited in claim 16 of the present application. While Castille does disclose video disks (*See* Castille at Column 5, lines 21-22) and displaying written documents (*See* Castille at

Column 3, lines 6-12), it does not teach, nor suggest, playing a song and showing graphics associated with the song. That is, Castille does not teach, nor suggest, "song associated graphics."

Similar to Castille, Cohen does not teach, nor suggest, a computer jukebox. Cohen relates to a video communication system for downloading movies in digital format from a large archive library. *See* Cohen at Abstract. Like Castille, Cohen does not teach, nor suggest "a data storage unit for storing received compressed digital song data, and compressed pictorial graphics" associated with the songs, as recited in claim 16. Further, Cohen does not provide the various other limitations recited in claim 16 that are missing in Castille. Thus, even assuming Castille and Cohen could be combined, which combination would be improper because neither is concerned with the problems confronted by an artisan having ordinary skill with respect to computer jukeboxes, and such combination could technically be accomplished only through hindsight, the combination does not teach, nor suggest, at least the following: (1) a computer jukebox; (2) storing received compressed digital song data in a data storage unit; (3) a money intake device; (4) a user attract mode; (5) song associated pictorial graphics; and (6) a data storage unit for storing received compressed digital song data, and compressed pictorial graphics associated with the songs, all of which are recited in claim 16 of the present application.

The Examiner noted that Verduin teaches displaying selected graphics when no video selection is playing. Verduin does not teach, nor suggest, a jukebox that plays *digital* songs or displays images that have been stored *digitally*. Even assuming that Castille, Cohen and Verduin could be combined, the combination does not teach, nor suggest, a computer jukebox that stores digital songs and digital song associated graphic images. Rather, Verduin discloses video cassette recorders and a graphics generator. The Examiner noted that "the leap from analog to digital is seen to be a natural progression of the art for the benefit of better audio and video playback," without pointing to anything in Verduin that would make up for Verduin's deficiency with respect to this limitation. Verduin simply does not teach, nor suggest, digital songs and images.

Tashiro discloses "a game playing system for commercial use and particularly to such a system enabling a plurality of players to play a game simultaneously in the same game space." Tashinro at Column 1, lines 5-9. Clearly, Tashiro is not a computer jukebox. As such, it does not

play songs as a jukebox does. Hence, Tashiro does not teach, nor suggest "song associated pictorial graphics," as recited in claim 16.

The combination of Castille, Cohen, and Tashiro or Verduin does not teach, nor suggest, a computer jukebox as recited in claim 16. Further, the combination does not teach, nor suggest, all of the limitations recited in the claims of the present application, at least for the reasons discussed above.

> To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure.

MPEP §2142. The Applicants respectfully submit that a *prima facie* case of obviousness has not been established because the proposed combination does not teach, nor suggest, all the limitations of the claims of the present application. Thus, the proposed combination cannot render claims of the present application unpatentable.

Even assuming that the proposed combination did teach all of the claim limitations of the claims of the present application, a *prima facie* case of obviousness is still not established because a person having ordinary skill in the art would not be motivated to combine Castille, Cohen, Verduin and/or Tashiro.

> When applying 35 U.S.C. 103, the following tenets of patent law must be adhered to:
> (A) The claimed invention must be considered as a whole;
> (B) The references must be considered as a whole and must suggest the desirability and thus the obviousness of making the combination;
> (C) The references must be viewed without the benefit of impermissible hindsight vision afforded by the claimed invention; and
> (D) Reasonable expectation of success is the standard with which obviousness is determined.

See MPEP 2141 at 2100-116, *citing Hodosh v. Block Drug Co., Inc.* 786 F.2d 1136, 1143 n.5, 229 USPQ 182, 187 n.5 (Fed. Cir. 1986). In considering the references as a whole, one would not be motivated to combine Castille with the other references.

Castille does not relate to computer jukeboxes at all. As discussed above, Castille is by no means functionally equivalent to jukeboxes. Further, Castille relates to a system including home subscribers. A home subscriber does not input money into a money intake device on his/her home computer. The home computer simply does not have a money intake device. Nor would one be motivated to put a money intake device, such as those shown in Verduin and Tashiro, on a home computer. That is, as home subscribers, there is no need to add a money intake device to the home computer. Additionally, as discussed above, Castille relates to a system of personalized music programs tailored to the preferences of a particular individual who listens to the music at home, which is far different than a jukebox. The Applicants respectfully submit that Castille, the primary reference, does not teach, nor suggest, a computer jukebox, nor does it describe a system having the functionality of a jukebox.

The Examiner attempts to combine Castille, a subscription network that does not teach, nor suggest, a computer jukebox (or the functionality of a computer jukebox), with Cohen, a home video communication system, and at least one of Verduin, a phonograph based (i.e., non-digital) jukebox that does not teach, nor suggest downloading songs, and/or Tashiro, which is directed towards video game systems, and, as such, is not relevant to jukeboxes. The only reference that is related to jukeboxes is Verduin, which discloses a stand-alone phonograph based jukebox. The Applicants respectfully submit that the Examiner is using hindsight to pick and choose isolated elements from disparate references.

> The tendency to resort to "hindsight" based upon applicant's disclosure is often difficult to avoid due to the very nature of the examination process. However, impermissible hindsight must be avoided and the legal conclusion must be reached on the basis of the facts gleaned from the prior art.

See MPEP 2142 at 2100-123 – 124. In combining these references, the Examiner has merely picked and chosen among isolated, individual elements of assorted prior art references from a wide

range of technologies, only one of which (Verduin) is related to an analog, stand-alone jukebox. The Examiner seems to be using the present application as a road map to pick and choose elements from disparate references to re-create the Applicants' invention. The Applicants respectfully submit that one having ordinary skill in the art would not be motivated to combine these disparate references. As such, a *prima facie* case of obviousness has not been established.

"The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination." *See* MPEP 2143.01 at 2100-126, *citing In re Mills,* 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990). "Although a prior art device 'may be capable of being modified to run the way the apparatus is claimed, there must be a suggestion or motivation in the references to do so.'" *See id.* The Examiner has offered no reasons why the references can be combined. In fact, the only reasons given for combining the references is that the references include the isolated elements. For example, the Examiner states:

> Castille ('502) discloses the storage of software... but does not specifically disclose the storage of the received compressed digital song data and the received song identify data in the data storage unit.
>
> Cohen ('187 teaches transmitting audio disks and updating an inventory list in a remote computer....
>
> Therefore, it would have been obvious to one of ordinary skill in the art, at the time the invention was made to cause the processor to respond to compressed digital song data and to song identity data which may be received by the communication interface of the computer jukebox, to control the storage of the received compressed digital song data and the received song identity data in the data storage unit, as taught by Cohen ('187) to create an update library of songs stored in the computer jukebox.

See Paper 16 at page 4. The Examiner uses the same approach for the other gaps of Castille. However, in doing so, the Examiner merely notes the missing limitation of Castille, picks an isolated element from another reference (such as Cohen), and then concludes that it would be obvious to combine the two merely because the additional reference teaches something in addition to Castille.

> In determining the differences between the prior art and the claims, the question under 35 U.S.C. 103 is not whether the differences

> themselves would have been obvious, but whether the claimed invention as a whole would have been obvious.

See MPEP 2141.02 at 2100-120, *citing Stratoflex, Inc. v. Aeroquip Corp.*, 713 F.2d 1530, 218 USPQ 871 (Fed. Cir. 1983); *Schenck v. Nortron Corp.*, 713 F.2d 782, 218 USPQ 698 (Fed. Cir. 1983). The Applicants submit that no reasons are provided as to why one would be motivated to combine the references. In effect, only conclusory statements that each isolated element is obvious are offered without considering the references, or the claims of the present application, as a whole. As discussed above, the references cannot be combined and therefore, the Applicants respectfully submit that a *prima facie* case of obviousness has not been established.

To summarize, the Applicants respectfully submit that not only does the combination of Castille, Cohen, Verduin, or Tashiro not teach, nor suggest, all the limitations of the claims of the present application, but one having ordinary skill would not be motivated to combine these disparate references. At least for the reasons discussed above (and during earlier prosecution of the present application), a *prima facie* case of obviousness has not been established with respect to these references, and, as such, these references cannot render the claims of the present application unpatentable.

The Applicants now turn to the rejection of claims 16-17, 20, 22, and 25-27 under 35 U.S.C. 103(a) as being unpatentable over William in view of Audiocomp. The Examiner pointed out that William does not disclose compression of digital files. That is, William does not teach, nor suggest, "a library of songs that have been digitally compressed and stored in the computer jukebox," or a "memory including a decompression algorithm for decompressing compressed digital song data," as recited, for example, in claim 16. Additionally, William does not teach, nor suggest, generating a user attract mode wherein digitally-stored song associated graphic images are shown on the display, as recited in claim 16. William discloses the following:

> If the entertainment item consists of a video, plus music, or a video only, the video can be displayed on the VDU, simultaneously with the music (if any). If a music item "record" has been released without a video, the VDU can, during play, display a still of the artiste(s) or a stock video or video loop of the artiste(s).

William at page 1, lines 56-63. However, William does not teach, nor suggest, generating a user attract mode wherein digitally-stored song associated graphic images are shown on the display, as recited in claim 16. Thus, for at least this reason, the combination of William and Audicomp does not teach, nor suggest, all the limitations of independent claims 16, 22 and 27. Because the combination of William and Audicomp does not teach, nor suggest, all the limitations of claims 16, 22 and 27, the Applicants respectfully submit that the claims of the present application should be in condition for allowance.

CONCLUSION

In light of the above, the Applicants request reconsideration of the application and look forward to working with the Examiner to resolve any remaining issues in the application.

If the Examiner has any questions or the Applicants can be of any assistance, the Examiner is invited to contact the undersigned. The Commissioner is authorized to charge any necessary fees or credit any overpayment to the Deposit Account of McAndrews, Held & Malloy, Account No. 13-0017.

Respectfully submitted,

Joseph M. Butscher
Registration No. 48,326
Attorney for Applicants

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MCANDREWS, HELD & MALLOY, LTD.
500 West Madison Street, 34th Floor
Chicago, Illinois 60661
Telephone: (312) 775-8000
Facsimile: (312) 775-8100